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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,023	03/18/2004	Hirokazu Ikeda	16869K-111100US	9205
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TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			NGUYEN, TAN D	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 10/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/805,023	Applicant(s) IKEDA ET AL.	
	Examiner Tan Dean D. Nguyen	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/18/04 & 2/28/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statements (2 IDS) submitted on (1) 3/18/04 and (2) 2/28/05 were filed after the mailing date of the filing on 3/18/04. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Status

Claims 1-20 are active and rejected as followed.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent thereof, subject to the conditions and requirements of this title.

3. As an initial matter, the United States Constitution under Art. 1, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts".

See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

4. Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions (3) include (1) "laws of nature", (2) "natural phenomena", and (3) "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Sirattlre Financial Group, Inc.* 149, F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

5. Mere idea in the abstract (i.e. abstract idea, law of nature, natural phenomena) that do not apply, involve, use or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e. physical sciences as opposed to social sciences, for example), and therefore are found to be non-statutory subject matter. For a process to pass muster, the recited process must somehow apply, involve, use or advance the technological arts.

6. This "two-prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-

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statutory using the Freeman-Walter-Abele test as applied to Gottschalk v. Benson, 409 U.S. 63, 175, USPQ 'IBNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

7. The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter is statutory, not on whether the product of the claimed subject matter is statutory, not on whether the prior art which the claimed subject matter purports to replace is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., but whether it "enhances" the operation of a machine. In re Toma at 857.

8. In Toma, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

9. The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court

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decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "whether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BPAI 2001).

10. Thus the present basis for a 35 USC 101 inquiry is a 2-prong test:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

11. **Claim 15 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.** As to the 2nd-prong test, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, as to claim 15, both steps of;

- (a) causing the device to receive an entry (data/information/parameter), and

(b) causing the device to change said entry (data/information/parameter), ..., better matches a control strategy of the information processing system, does not appear to produce a concrete or tangible result. Even though there is a relationship of the device and the system as shown in the preamble, it's not clear the how the steps (a) "causing" and (b) "causing" produce a concrete and tangible for controlling the information processing **device**.

Claim Rejections - 35 USC § 112

12. Claim 15 (method), 1-7, 16-17 (product), 8-14, 18-20 (apparatus) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 calls for a method for "controlling an information processing device" but the steps as shown,

(a) causing the device to receive an input which is a parameter ("entry" which is a data about something), and

(b) causing the device to change the data/information/parameter ... said information processing system"

1) do not appear to meet the scope of the claimed invention. In fact the claim language discuss more about the "information processing system" which includes the device. Note that the term "causing ... to receive" is merely mean "receiving". The last step (b) deals with the system and not the device. It's not clear how the last phrase of

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"better matches the control strategy of the information processing system" relates to the information processing device or meets the scope of "controlling the information processing device".

2) Step (b) is vague because it's not clear what the parameter is changed into what?

3) Claim 15 is vague and confused because it's not clear how "a parameter" or a single input "entry" or "data", i.e. "name", "id number", etc. is capable of (a) "setting policies in which processes to be performed in said information processing system are defined" and (b) "so that a policy set, ..., better matches a control strategy of the information processing system".

4) Claim 15 is vague and indefinite because it's not clear what are the processes in the phrase "in which processes to be performed in said information processing system are defined"

5) Claim 15 is vague and indefinite because it's not clear the relationship of the "policy set" to the information processing device.

6) Independent claims 1 and 8 are rejected for nearly the same reasons (1) –(5) set forth in independent claim 1 above since they have similar language.

7) Claim 18 recites the limitation "said storage device, said backup device, said computer, and said network device, which ..., said acquired operation performance information" in lines 3-5. There is insufficient antecedent basis for these "said" limitations in the claim.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. **Claims 1-7, 16-17, 8-14, 18-20 are rejected under 35 U.S.C. 102(b) as anticipated by FRIEDRICH et al (US Patent 5,276,877).**

As for independent product claim 1, which is a computer-readable medium, FRIEDRICH et al discloses a computer-readable medium containing a computer software program for causing a computer to perform a process {see disk D1 of Fig. 1 (160) or disk D4, Fig. 1, (166), or disk D5, Fig. 1 (168) or File of Fig. 3a (305 “.MDL”), or (345 “.MDL”)}. As for the phrase “the program comprising: code for allowing, and code for changing”, these carry no patentable weight since they are merely considered as code and these will read over the codes of FRIEDRICH et al. Note that in a compound claim, i.e. a computer-readable medium, the only things that carry patentable weight are that “*the medium containing computer software program for causing or instructing a computer to do something (steps)*”. This is shown in the specification page 2, lines 15-20, but are not properly claimed. Any thing else are merely codes containing in a computer-readable medium, and these do not carry any patentable weight and are read over by the codes in FRIEDRICH et al files or disk.

As for dep. claims 2-4 (part of 1 above), which further limit item or element related to the code above, i.e. information processing system, these also carry no

patentable weight. There are nothing in here further limit the “program for causing a computer to perform a process” as shown in the preamble. Note that a product claim is limited by elements and not how the elements are manipulated.

As for dep. claims 5-7, 16-17 (part of 1 above), which further limit item or element related to the code above, i.e. information processing system, these also carry no patentable weight. There are nothing in here further limit the “program for causing a computer to perform a process” as shown in the preamble. Note that a product claim is limited by elements and not how the elements are manipulated.

As for independent apparatus (device) claim 8, FRIEDRICH et al discloses an information processing device included in an information processing system comprising:

(a) an input receiver configured to receive a parameter (input or entry or data or information) entered {see Fig. 3(a) , 320, 322, or col. 7, lines 9-11, col. 8, lines 8-15},

(b) a parameter (input or entry or data or information) changer configured to change the parameter {see col. 8, lines 16-21 or Fig. 3(a), 330}. As for the further limitation of the parameter “for setting policies”, this carries no patentable weight because this is merely intended use of the parameter or further limiting the object of the element “input receiver” and not the element “input receiver” itself. A parameter is not an element or elemental structure of the device, thus carrying no patentable weight in an apparatus claim. A policy, policy set, or policies are merely objects or function and are not elements or elemental structures of the device, thus carrying no patentable weight in an apparatus claim. **Note** that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished

from the prior art in terms of **structure** rather than function. See *In re Schreiber*, 128 F. 3d 1473, 1477-1478, 44 USPQ2d 1429, 1431-1432 (Fed. Circuit 1997). See MPEP 2114 [R-1]. **Note:** See claim 25, col. 36, of FRIEDRICH et al for a typical demonstration of a proper apparatus claim.

Dependent claims 9-11 (part of 8 above), further deals with limitations related to parameter or policy, policies, or set of policies mentioned above, thus carrying no patentable weight as described above. Only elements related input receiver or parameter changer receive patentable weight.

Dependent claims 12-13 (part of 8 above), further deals with functions limitations of the parameter charger, i.e. "*calculates a ... value*", and this has no patentable weight since no elemental structures have been shown.

Dependent claims 14, 19-20 (part of 8 above), which deals with further limitation of the "parameter" "for specifying said policies ..." "setting policies", this carries no patentable weight because this is merely intended use of the parameter or further limiting the object of the element "input receiver" and not the element "input receiver" itself. A parameter is not an element or elemental structure of the device, thus carrying no patentable weight in an apparatus claim. A policy, policy set, or policies are merely objects or function and are not elements or elemental structures of the device, thus carrying no patentable weight in an apparatus claim. **Note** that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of **structure** rather than

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function. See *In re Schreiber*, 128 F. 3d 1473, 1477-1478, 44 USPQ2d 1429, 1431-1432 (Fed. Circuit 1997). See MPEP 2114 [R-1].

Dependent claim 18 (part of 8 above), further deals with functions limitations of the parameter charger, i.e. "*uses said acquired operation performance information*", and this has no patentable weight since no elemental structures have been shown. As for the limitation of "an acquisition section configured to acquire an input / information, this is inherently in Fig. 3(a) or Fig. 4 or col. 8, lines 8-20, col. 9, lines 40-60.

No claims are allowed.

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15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).


In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
October 25, 2005


DEANT.NGUYEN
PRIMARY EXAMINER